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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,111	02/11/1999	ICHIRO NAKANO	1046.1196	8405

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EXAMINER
AN, SHAWN S

ART UNIT	PAPER NUMBER
2621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/248,111	NAKANO ET AL.
	Examiner	Art Unit	
	SHAWN AN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 November 2008</u>.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-4 and 24</u> is/are pending in the application.
    4a) Of the above claim(s) <u>5-22</u> is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-4 and 24</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1.   The request filed on 11/18/08 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/248,111 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2.   As per Applicant's instructions as filed on 11/18/08, claims 1, 3-4, and 24 have been amended, and claim 23 has been canceled.

Response to Remarks

3.   Applicant's arguments with respect to amended claims as above have been carefully considered but are moot in view of the following new grounds of rejection incorporating previously cited prior art references and a newly cited prior art reference.

        As per Applicant's arguments regarding claim 2, Yamaguchi et al discloses a data integrating unit (155) integrating the compressed area information from the area information encoding unit, wherein the compressed moving image data is changed in entirety in accordance with the area information without effecting the moving image data (col. 25, lines 64-67; col. 26, lines 1-2). Furthermore, as previously discussed, Yamaguchi et al discloses all of the claimed subject matter(s) with the exception of *digital* moving image. However, a process/concept of converting from an analog video signal to a digital video signal (such as a conventional A/D converter) is conventionally/fundamentally well known in the art.

        Moreover, Katto's reference was only relied upon as teaching a moving image encoding apparatus and, more particularly, to *high-efficiency* encoding of a *digital* moving image signal (col. 1, lines 5-7).

Therefore, it would have been considered quite obvious to a person of ordinary skill in the relevant art employing a moving image data controlling apparatus as taught by Yamaguchi et al to incorporate Katto's teaching as above so that the moving image source input unit inputs digital moving image data comprising plural data of a predetermined partial image unit, and the moving image data encoding unit compresses the digital moving image data from the digital moving image source input unit in order to achieve _high-efficiency_ encoding of a digital moving image data/signal. In other words, a clear reason for combining the Katto's reference is to further achieve _high-efficiency_ encoding of a _digital_ moving image data/signal.

Moreover, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See _In re Keller_, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); _In re Merck & Co.,_ 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (6,256,346 B1) in view of Ubillos (5,999,173).

Regarding claims 1 and 3, Yamaguchi et al discloses a moving image data controlling apparatus, comprising:

a moving image source input unit inputting moving image data containing image frames (Fig. 5, 700);

a moving image data encoding unit (141) compressing the moving image data from the moving image source input unit;

an information input unit (55 and/or 50; Fig. 21, Alpha-Map) inputting control/additional information externally produced and designating a processing for arbitrary designated partial image data (map information signal for distinguishing a background from an object in a picture) among the image frames of the moving image data inputted through the moving image source input unit, wherein the processing is implemented to each of the image frames (each picture/frame) of the moving image data in entirety responsive to designation of the partial image data (map information as above) (col. 20, lines 25-40; col. 25, lines 64-67; col. 26, lines 1-2);

a control information encoding unit (Fig. 21, 2006) compressing the control/additional information from the information input unit (abs.; col. 7, lines 19-21; col. 25, lines 64-67);

a data integrating unit (155) integrating the compressed image data from the moving image data encoding unit with the compressed control information from the control information encoding unit without effecting the moving image data (col. 25, lines 64-67; col. 26, lines 1-2); and

storing the integrated moving image data and the control information (161).

Yamaguchi et al does not particularly disclose a display effect processing causing the partial image data to be displayed with the display effect, wherein the display effect processing is implemented to each of the image frames of the moving image data (video clip), wherein the control information causes the partial image data to be displayed with the display effect upon being displayed.

However, Ubillos teaches apparatus/method for video editing with video clip representations displayed along a time line comprising a display effect processing causing the partial image data (a square) to be displayed with the display effect, wherein the display effect processing is implemented to each of the image

frames of the moving image data, wherein a control information (lengthening control icon 92 or 94; user command) causes the partial image data to be displayed with the display effect upon being displayed, so as to dynamically generate each video clip to be displayed by retrieving from storage all frames of the video clip with a user selected time compression factor and displaying the retrieved frames (Fig. 14; Abs.; col. 13, lines 29-50).

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing a moving image data controlling apparatus as taught by Yamaguchi et al to incorporate Ubillos' teachings as above so that Yamaguchi et al's information input unit designates a display effect processing for arbitrary designated partial image data, wherein the display effect processing causes the partial image data to be displayed with the display effect, wherein the display effect processing is implemented to each of Yamaguchi et al's image frames of the moving image data, wherein the control information causes the partial image data to be displayed with the display effect upon being displayed, so as to dynamically generate each video clip to be displayed by retrieving from storage all frames of the video clip with a user selected time compression factor and displaying the retrieved frames.

Regarding claim 24, Yamaguchi et al discloses a method of controlling image data, comprising;

compressing the moving image data (Fig. 5, 141) containing image frames (700);

designating an arbitrary portion among the image frames, and defining the arbitrary position (bit-map, alpha-map) as control/additional information (map information signal for distinguishing a background from an object in a picture) with respect to each of the image frames (each picture/frame) of the moving image data in entirety responsive to the designating, the control information being compressed (Fig. 21, 2006; col. 20, lines 25-40; col. 25, lines 64-67; col. 26, lines 1-2); and

displaying the moving image data by integrating an image data resulting from the compressing of moving image data and the compressed control information (155; col. 25, lines 64-67; col. 26, lines 1-2).

Yamaguchi et al does not particularly disclose <u>designating a display effect, thereby causing the image data to have the display effect while the image data is being displayed</u>.

However, Ubillos teaches apparatus/method for video editing with video clip representations displayed along a time line comprising designating a display effect, thereby causing the image data to have the display effect while the image is being displayed, so as to dynamically generate each video clip to be displayed by retrieving from storage all frames of the video clip with a user selected time compression factor and displaying the retrieved frames (Fig. 14; Abs.; col. 13, lines 29-50).

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing a moving image data controlling apparatus as taught by Yamaguchi et al to incorporate Ubillos' teachings as above so that the Yamaguchi et al's control information designates a display effect, thereby causing the image data to have the display effect while the image data is being displayed, so as to dynamically generate each video clip to be displayed by retrieving from storage all frames of the video clip with a user selected time compression factor and displaying the retrieved frames.

6.   Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (6,256,346 B1) in view of Katto (5,694,171) as previously discussed in the last Office action as filed on 5/14/08.

7.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Yamaguchi et al (6,256,346 B1) in view of Hancock et al (6,195,391 B1) and Ubillos
(5,999,173).

        Regarding claim 4, Yamaguchi et al discloses all of the claimed subject
matter as discussed above with respect to amended claim 3 with the exceptions
of a pre-amble (a computer readable medium …, to execute operations,), and a
display effect processing causing the partial image data to be displayed with the
display effect, wherein the display effect processing is implemented to each of
the image frames of the moving image data, wherein the control information
causes the partial image data to be displayed with the display effect upon being
displayed.

        However, Ubillos teaches apparatus/method for video editing with video clip
representations displayed along a time line comprising a display effect processing
causing the partial image data (a square) to be displayed with the display effect,
wherein the display effect processing is implemented to each of the image
frames of the moving image data, wherein a control information (lengthening
control icon 92 or 94; user command) causes the partial image data to be
displayed with the display effect upon being displayed, so as to dynamically
generate each video clip to be displayed by retrieving from storage all frames of
the video clip with a user selected time compression factor and displaying the
retrieved frames (Fig. 14; Abs.; col. 13, lines 29-50).

        Further, Hancok et al teaches hybrid video compression/decompression system
comprising performing/practicing the invention on a digital computer system storing a
program which when executed by a computer causes the computer to execute
operations (col. 4, lines 45-53), and also teaches bit-map encoding (col. 3, lines 11-17)
as it is traditionally/conventionally well known to implement computer software as
opposed to hardware for achieving the same operations/results, since the software

saves significant overhead operating/manufacturing costs in comparison with the cost of manufacturing hardware.

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing a moving image data controlling apparatus as taught by Yamaguchi et al to incorporate Ubillos' teachings as above so that Yamaguchi et al's information input unit designates a display effect processing for arbitrary designated partial image data, wherein the display effect processing causes the partial image data to be displayed with the display effect, wherein the display effect processing is implemented to each of Yamaguchi et al's image frames of the moving image data, wherein the control information causes the partial image data to be displayed with the display effect upon being displayed, so as to dynamically generate each video clip to be displayed by retrieving from storage all frames of the video clip with a user selected time compression factor and displaying the retrieved frames, and also incorporate Hancock et al's teachings as above so that a computer readable medium stores a (computer) program which when executed by a computer causes the computer to execute Yamaguchi et al and Ubillos' claimed methods, thereby saving significant overhead operating/manufacturing costs in comparison with the cost of manufacturing hardware.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn An* whose telephone number is 571-272-7324.

9.   The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAWN AN/

Primary Examiner, Art Unit 2621

12/18/08